

#12
CJGAMENDMENT AFTER FINAL REJECTION
EXPEDITED PROCEDURE EXAMINING GROUP 1700

BOX AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hideki USUKI et al.

Group Art Unit: 1775

Serial No.: 09/684,927

Examiner: Ling X. Xu

Filed: October 10, 2000

For: PROTECTIVE LAYER TRANSFER SHEET

REQUEST FOR RECONSIDERATIONCommissioner for Patents
Washington, D. C. 20231

Sir:

Applicants request reconsideration of the rejection in the Final Rejection mailed September 23, 2002 in view of the following remarks.

The rejection of claims 1 and 4 to 9 under 35 USC 103 as unpatentable over Oshima et al. '997 in view of Kanto '112 is respectfully traversed.

The present invention is directed to an improved protective layer transfer sheet that is able to prevent meandering or cockling of the sheet when it is within a printer. Applicants have found

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that the particular claimed controls, especially the quantity of microsilica in the adhesive layer and the coefficient of friction between the surface of the protective layer and the surface of an image-receiving sheet prior to thermal transfer falling within the designated ranges for coefficient of static friction and coefficient of dynamic friction are necessary to achieve these indicated objectives. The advantages of the invention are demonstrated in the specification in the discussion of the working and comparative examples. The Examiner is referred especially to the specification at page 21, line 14 to page 24, line 21.

The Examiner acknowledges that Oshima et al. '997 does not teach the instantly claimed subject matter because there is no disclosure in the reference of an adhesive layer containing microsilica in the range of 3 to 10%.

Applicants point out that Oshima et al. '997 also does not disclose the stated relationship of the coefficients of friction specified in the instant claims. This relationship is a further condition necessary to satisfy the objectives of the present invention. The Examiner is again directed to the working and comparative examples in the specification.

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The Examiner cites Kanto et al. '112 to show the incorporation of fine particles into an adhesive layer to reduce the coefficient of friction. The Examiner also cites the reference for disclosure of a range of fine particles of from 0.1 to 10% by weight (not the range in applicants' claims) and the use of silica as a particle; the Examiner states that the reference teaches microsilica "because the thickness of the adhesive layer is on the order of a μm " although the patent itself does not so state.

The Examiner then concludes that it would have been obvious to combine the reference teachings to form the subject matter claimed and by doing so one would "reduce the coefficient of friction on the surface of the adhesive layer"; see the last sentence of the second paragraph on page 3 of the Office Action. The Examiner asserts that the combination would "have the same properties as claimed, such as the coefficient of friction values"; see the last sentence in the fourth paragraph at page 3 of the Office Action. Applicants say that merely combining the primary and secondary references does not result in the invention as claimed here, whose advantages (ones conferring patentability) are established by the working and comparative examples in the case.

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Applicants respectfully submit that the comments in the Response to Arguments do not defeat patentability. For example, applicants say that the second sentence in the third paragraph of the Response to Argument section is classic hindsight and shows the use of applicants' specification, indeed applicants' discovery, to justify the rejection. There is nothing in either reference that shows the specific controls on the amounts of microsilica and the coefficients of friction recited in the claims.

Applicants also respectfully submit that the first and second paragraphs on page 5 of the Final Rejection show classic hindsight because Kanto et al. '112 provides no proper rationale to increase the microsilica content in the adhesive layer of Oshima et al. '997. The working and comparative examples, moreover, establish why one should not use less than 3% of microsilica, a matter neither taught nor suggested in either reference.

The last paragraph at page 5 of the Final Rejection contains the Examiner's assessment of the values shown in the working and comparative examples. The Examiner states that the values would be "the direct result of having microsilica in the range of 0.3 to 10% in the adhesive layer." The values for the working examples are of

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course "the direct result" of operating within the limits of the claimed invention but in no way diminish the nature of the showing. The working examples clearly show results significantly better than those shown in the three comparative examples wherein the first comparative examples uses no filler, the second comparative example uses microsilica in a quantity significantly below that claimed, and the third comparative example uses microsilica in amounts significantly above that of the claimed range. The Examiner is again directed to the discussion in the specification at page 21, line 14 to page 24, line 21. Evidence in support of patentability clearly exists in this case and cannot be dismissed as merely the "direct result" of practicing the claimed invention. Patentability is proven here. The rejection should be withdrawn.

Reconsideration of the rejection in view of the above remarks and allowance of the case are earnestly solicited.

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The Examiner is requested to telephone the undersigned if anything further is required in the case.

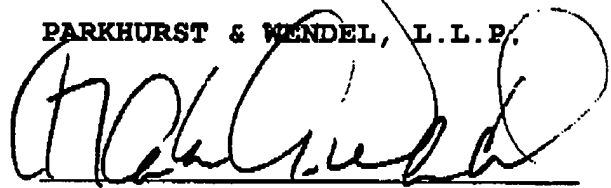
Respectfully submitted,

PARKHURST & WENDEL, L.L.P.

March 24, 2003

Date

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To: Examiner Ling X. Xu
Group Art Unit 1775

Date: 3/25/03

Company: U.S. PTO

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From: Charles A. Wendel

Re: U.S. Patent Appln. Serial No. 09/684,927
Hideki USUKI et al. - Our Ref.: DAIN:563

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Dear Examiner Xu:

On March 24, 2003 we filed a Request for Reconsideration, three month extension of time and Notice of Appeal in the USPTO Mail Room.

Transmitted herewith are courtesy copies thereof and of our firm's return postcard receipt bearing the USPTO Mail Room date stamp confirming that filing.

This copy is presented for your convenience to expedite your consideration of this case. We await receipt of a Notice of Allowability or Advisory Action.

Respectfully submitted,

PARKHURST & WENDEL, L.L.P.

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DAIN: 563
Atty. Docket No. REQUEST FOR RECONSIDERATION; THREE MONTH
Description: EXTENSION OF TIME & \$930; NOTICE OF APPEAL &
\$320 (# 16393)
Inventor(s): Hideki USUKI et al.
Title (new cases): PROTECTIVE LAYER TRANSFER SHEET
Attorney: CAW/ch Serial No. 09/684,927
Paper(s) Filed: March 24, 2003
Date(s) Satisfied: March 23, 2003
N.D.D.: c/u. 4/24 AB due 5/24, 5/24 AB due

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